

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

GEORGE V. DELUCCA

PATENT NO.: 7,504,211

Confirmation No. 5265

ISSUED: March 17, 2009

FOR: METHODS OF USING EPHA2 FOR PREDICTING ACTIVITY OF
COMPOUNDS THAT INTERACT WITH AND/OR MODULATE PROTEIN TYROSINE
KINASES AND/OR PROTEIN TYROSINE KINASE PATHWAYS IN BREAST CELLS

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PERIOD
IN GRANTED PATENT UNDER 37 C.F.R. 1.181 and 1.705(d)**

Sir/Madam:

This is a request for reconsideration of the patent term adjustment for the captioned patent.

Statement of the Facts

As required under 37 C.F.R. § 1.705(b)(2), Applicant provides the following statement of the facts involved.

The patent term adjustment history from PAIR shows a USPTO delay of 281 days and Applicant's delay 313 days. This delay was calculated as follows:

USPTO Delay:

06-20-2005	Mail Restriction Requirement	237 days
10-23-2008	Mail Notice of Allowance	18 days
02-25-2009	PTA 36 Months	<u>26 days</u>

281 days

Applicants Delay:

09-14-2006	Response after Non-Final Action	92 days
12-05-2006	Information Disclosure Statement	82 days
04-18-2007	Notice of Appeal	30 days
07-11-2007	Information Disclosure Statement	56 days
12-07-2007	Response after Non-Final Action	29 days
06-05-2008	Response after Non-Final Action	<u>24 days</u>

313 days

However, as indicated below, the period of USPTO delay for calculating the patent term adjustment should be 858 days.

35 U.S.C. § 154(b) provides for adjustment of patent term due to certain delays of the USPTO. This includes the “A period” of 35 U.S.C. § 1.54(b)(1)(A) (concerning failure of the USPTO to comply with deadlines enumerated therein) and the “B period” of 35 U.S.C. § 1.54(b)(1)(B) (concerning failure of the USPTO to issue a patent within 3 years of filing).

In *Wyeth v. Dudas* (2008 WL 4445642 (D.D.C. September 30, 2008)), the United States District Court of the District of Columbia rejected the USPTO’s view¹ that any administrative delay under the “A period” (35 U.S.C. § 154(b)(1)(A) period) overlays any 3-year maximum pendency delay under the “B period” (35 U.S.C. § 154(b)(1)(B) period) (i.e., that applicant gets credit for “A period” or for “B period,” whichever is larger, but never “A period” + “B period”). Rather, the *Wyeth* court held that the “A period” (35 U.S.C. § 1.54(b)(1)(A)) and the “B period” (35 U.S.C. § 1.54(b)(1)(B)) overlap *only* if they occur on the *same calendar day or days*. In view of the *Wyeth* decision, Applicant submits this request for reconsideration of the patent term adjustment period.

¹ See, 69 Fed. Reg. 34238 (2004).

In the instant case, the 237 day delay occurring in the "A period" (35 U.S.C. § 154(b)(1)(A) period) and the 934 day delay occurring in the "B period" (35 U.S.C. § 154(b)(1)(B) period) do not occur on the same calendar day or days. In particular, the 934 day USPTO delay occurring in the "B period" (beginning August 26, 2006, three years after the patent application was filed, and ending on the issue date of March 17, 2009) does not overlap with the 237 day USPTO delay occurring in the "A period" (beginning October 26, 2004 and ending June 20, 2005) with the mailing of a Restriction Requirement..

Accordingly, in view of *Wyeth*, Applicant is entitled to the combination of the ("A period" 237 days and the "B period" 934 days minus Applicants Delay of 313 days), which results in a patent term adjustment of 858 days. Applicant requests reconsideration of the patent term adjustment period.

A Terminal Disclaimer over application number 11/072,175 (now granted patent number 7,537,891) was filed on September 29, 2008.

Timeliness of this Request


As this request is being filed within two months of the patent's issue date, it is timely under 37 C.F.R. § 1.705(d).

Request Fee

As required under 37 C.F.R. § 1.705(b)(1), please charge the \$200.00 fee prescribed in 37 C.F.R. § 1.18(e) to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company. Please charge any additional fees, or credit any overpayment, to the same account.

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